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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,379	01/30/2002	Thomas C. McFarland	100200351-1	4528

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Intellectual Property Administration
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EXAMINER

PHAM, HAI CHI

ART UNIT	PAPER NUMBER
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2861

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,379

Applicant(s)

McFARLAND ET AL.

Examiner

Hai C Pham

Art Unit

2861

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14-25, 27-29, 33-37, 39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11, 14-25, 33-37, 39 and 40 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claim 30 whose recited limitation is now incorporated into claim 27, is withdrawn in view of the newly discovered reference to Nikles et al. (U.S. 4,937,119). Rejections based on the newly cited reference follow.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer (Pub. No. U.S. 2002/0145614 A1) in view of Kahle (U.S. 6,074,031).

Van Valer discloses a method for labeling of photo compact discs with a photo table of contents, the method consisting of selecting the digital photos to be stored on a target photo compact disc and designing the photo table contents label that will be printed onto that target photo compact disc, the selection and collection of the digital photos being downloaded by the user from a Web server and temporarily stored into the user-end system (paragraph [0012]), which coordinates with the index sizing module to ensure that the user is not attempting to overload the capacity of the printable surface area on the target CD, e.g. the maximum number of standard thumbnail images that

Art Unit: 2861

can be imprinted onto the non-data surface area of the target CD as a label (paragraph [0013]).

However, Van Valer fails to teach the user-input of the size of the storage media.

Kahle, an acknowledged prior art, discloses a method and apparatus for printing labels on digital recording media in which the label data is encoded on the digital recording media (col . 5, line 66 to col. 6, line 5), and means for printing (label printer 2) being connected to a driver, which provides a template showing the outline of the label as well as the label formatting and data sorting (col. 5, lines 26-40). Kahle further teaches the input device accepting an input indicating a size of the storage media (the template for outlining the label indicating the size of the storage media) (col. 5, lines 45-55).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Van Valer with the aforementioned teaching of Kahle. The motivation for doing so would have been to allow the label to be cut proportional to the size of the storage media.

Van Valer further teaches:

- means for storing a composite file that includes the arranged images (the XML-to-label-image converter transforming the XML data and the associated thumbnail images into a simple bitmap image of the TOC sized to the proportions of the target photo compact disc (paragraph [0013]);
- means for printing said images including a laser (using an HP LaserJet printer);

Art Unit: 2861

- said means for printing said images including a printhead that prints said images on a side of said storage media (labeling of photo compact discs with a photo table of contents including printing directly onto the plastic CD or onto an adhesive label using a label printer, which necessarily includes a printhead (paragraph [0062])).

4. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Valer in view of Nikles et al. (U.S. 4,937,119).

Van Valer discloses a storage media comprising a first side, which stores encoded images (user's photo-storing CD), a second side (label side of the CD), which stores images correspond to said images encoded on said first side (graphical elements for the CD label corresponding to the contents or photos burned into the first side of the photo CD) (paragraph [0062]), wherein said images that correspond to said images encoded on said first side are printed using a laser (HP LaserJet printer) (paragraph [0050]).

However, Van Valer fails to teach the storage media including microencapsulated fluid droplets that respond to the laser.

Nikles et al. discloses an optical data storage medium comprising a textured surfaced information layer comprised of at least one encapsulated dye, which strongly absorbs at a specific wavelength of the laser of sufficient intensity.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the optical data storage medium of Van Valer

Art Unit: 2861

with a microencapsulated dye layer that responds to the laser at specific wavelength since Nikles et al. teaches this to be known in the art to be capable of storing extremely and effectively high density information.

Allowable Subject Matter

5. Claims 6-11, 14-25, 33-37, 39 and 40 are allowed.
6. The reasons for allowance of the above claims have been expressed in the previous Office action issued on 09/30/03.

Response to Arguments

7. Applicant's arguments filed 01/02/04 have been fully considered but they are not persuasive with regard to the amended claim 1.

Applicant states that claim 1 has been amended to include the allowable subject matter recited in claim 13 to render claim 1 allowable. However, claim 1 has been actually amended to include a feature recited in claim 12, which is now canceled, claim 12 being rejected under the combination of Van Valer and Kahle.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (571) 272-2260. The examiner can normally be reached on M-F 8:30AM - 5:30PM.

Art Unit: 2861

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



HAI PHAM
PRIMARY EXAMINER

April 1, 2004